

REMARKS

By the present amendment, claims 1, 2, 7, 8 and 10 have been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. In addition, dependent claims 18 through 20 have been canceled and dependent claims 30 through 32 have been added. Entry of these amendments is respectfully requested.

In the Action, claims 2-6 were rejected under the second paragraph of 35 USC § 112 as being indefinite. Specifically, it was noted that a phrase apparently lacked antecedent basis and it was alleged that the scope of the claim was not clear. Reconsideration of this rejection in view of the above claim amendments and the following comments is respectfully requested.

As mentioned above, claim 2 has been amended herein to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. It is submitted that the claims are now in full conformity with the provisions of the cited statute. Accordingly, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 1, 7, 8 and 10 were rejected under 35 USC § 102(b) as being anticipated by, or the alternative, under 35 USC § 103(a) as being unpatentable over, the patent to Chen et al. Reconsideration of this rejection in view of the above claim amendments and the

following comments is respectfully requested.

It is submitted that the cited Chen et al patent does not teach or suggest the semiconductor device as defined by independent claims 1, 7 and 10 and the claims dependent thereon. More particularly, it is to be noted that independent claims 1, 7 and 10 require, in part:

a [first and second] heat conductor formed in a first hole in the SiC substrate and made of a linear structure of carbon elements oriented in a depth direction of the first [second] hole...

The patent to Chen et al was cited in the Action for disclosing heat conductor 33 at col. 5, lines 4-38 thereof. It was further asserted that the Chen et al patent discloses that one of the suitable materials for heat conductor 33 is carbon fiber, citing col.5, line 24 thereof.

However, the Chen et al patent contains no teaching or suggestion with respect to, among other things, carbon fiber that is made of carbon elements oriented in a depth direction of the first or second hole as is presently claimed. It is a well established principle of U.S. patent practice that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (see MPEP 2131). In the present application, the subject matter "carbon elements oriented in a depth direction of the first (second) hole" is not taught or suggested in the Chen et al patent as noted above. In addition, there is no suggestion anywhere in the Chen et al patent of making the carbon fiber from the carbon elements oriented in a

depth direction of the first or second hole. Thus, the Chen et al patent does not disclose all elements recited in independent claims 1, 7 and 10.

In rejecting claim 10, it was asserted in the Action that the first surface of the substrate 25 according to the Chen et al patent is the surface that defines hole 27b. Claim 10 now recites "a second heat conductor formed to cover the first upper surface of the SiC substrate entirely." Since the surface defining the hole 27b disclosed in the Chen et al patent is not an "upper surface," it is submitted that the above assertion contained in the Action is not now applicable to the present claims.

Regarding the obviousness rejection of claim 8, it is believed that the rejection is also inapplicable, since claim 8 is dependent on claim 7.

In conclusion, it is respectfully requested that the examiner reconsider the rejections of record with a view toward allowance of the claims as amended which distinguish over the teachings of the cited patent. Accordingly, withdrawal of the rejection under 35 U.S.C. §102 (b) and §103(a) and allowance of claims 1 through 10 and 30-32 as amended over the cited Chen et al patent are respectfully requested.

Applicants acknowledge with appreciation the indication that claim 9 would be allowable if rewritten to include all the limitations of the base claim.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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